

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Vermehren et al
Serial No. : 10/089,288
Filed : March 26, 2002
For : **PROCESS FOR PREPARING SUBSTITUTED
PHENYLSULFONYLUREAS FROM SULFONYL HALIDES**
Confirmation
No. : 9367

745 Fifth Avenue
New York, New York 10151

EXPRESS MAIL

Mailing Label Number: EV 142961130 US

Date of Deposit: March 13, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Patents, Washington, DC 20231.

Edward Nay
(Typed or printed name of person mailing paper or fee)

Edward Nay
(Signature of person mailing paper or fee)

RENEWED REQUEST FOR REFUND

Commissioner for Patents
Box PCT
Washington, D.C. 20231
Attention: PCT LEGAL OFFICE

Sir:

On December 18, 2002, we filed a response to the Notification of Missing Requirements for this application. Along with the response, we filed a "request for refund" for the cost of the fee for a four-month extension of time since we did not receive the Notification of Missing Requirements until November 21, 2002 by facsimile.

On January 25, 2003, we received a paper dated January 22, 2003 refusing our request for refund since we did not include "item (3)", a docket record for all responses due for applicant's representative for August 19, 2002. We have enclosed the docket record for August 19, 2002, as well as the docket record for August 18, 2002, for all responses due for applicant's representative.


Also enclosed is a copy of the Declaration, including a cover sheet for both signature pages. The corrected Declaration was also submitted in response to the Notification of Defective Response dated February 13, 2003.

Reconsideration for the "request for refund" is respectfully requested. To the extent that a petition is necessary, this paper will serve as such, and the Commissioner is authorized to charge the petition fee, or any additional fee, to Deposit Account 50-0320.

It is respectfully submitted that the Applicants are entitled to a refund in the amount of \$1440.00, which covers the four-month extension fee. The Commissioner is respectfully requested to pay the refund by crediting Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: 
William F. Lawrence
Registration No. 28,029
745 Fifth Avenue
New York, New York 10151
(212) 588-0800

COMBINED DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

As below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below, I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

Process for preparing substituted phenylsulfonylureas from sulfonyl halides

the specification of which

Appln. Ser. No. 10/089,288

Filed March 26, 2002

- is attached hereto

- was filed on September 28, 2000 as International Application PCT/EP00/09466 and including all the amendments through the date hereof.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s) for which Priority is Claimed:

Federal Republic of Germany, 199 46 341.7 of September 28, 1999

And I hereby appoint

William F. Lawrence, Registration No. 28,029, of the firm FROMMER LAWRENCE & HAUG, LLP whose post office address is 745 Fifth Avenue, New York, New York 10151, or their duly appointed associate, my attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to file continuation and divisional applications thereof, to receive the Patent, and to transact all business in the Patent and Trademark Office and in the Courts in connection therewith, and specify that all communications about the application are to be directed to the following correspondence address:

**William F. Lawrence, Esq.
c/o FROMMER, LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, New York 10151**

Direct all telephone calls
to: (212) 588-0800, to the
attention of:
William F. Lawrence

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Appln. Ser. No. 10/089,288

Filed: March 26, 2002

INVENTOR(S) / Residence

1) Dr. Jan Vermehren, Im Hinterlenzen 33, 65510 Idstein, Germany

Signature: Jan VermehrenDate: 20-Feb-2002

2) Dr. Ernst Schmidt, Römerstrasse 7, 84556 Kastl, Germany

Signature: Ernst SchmidtDate: 1.3.02

3) Dr. Mark James Ford, Geierfeld 19, 65812 Bad Soden, Germany

Signature: Mark James FordDate: 26.02.2002

4) Dr. Richard W.G. Foster, Aventis CropScience UK Limited, Process Development, Hauxton, Cambridge CB2 5HU, Great Britain

Signature: _____

Date: _____

5) Dr. Ian A. Bourne, Aventis CropScience UK Limited, Process Development, Hauxton, Cambridge CB 2 5HU, Great Britain

Signature: _____

Date: _____

The inventors are citizens of

1)+2) Germany
3)-5) Great Britain

Post Office Address of all Inventors:

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COMBINED DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

As below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below, I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

Process for preparing substituted phenylsulfonylureas from sulfonyl halides

the specification of which Appln. Ser. No. 10/089,288
 - is attached hereto Filed March 26, 2002
 - was filed on September 28, 2000 as International Application PCT/EP00/09466
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I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

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William F. Lawrence, Registration No. 28,029, of the firm FROMMER LAWRENCE & HAUG, LLP whose post office address is 745 Fifth Avenue, New York, New York 10151, or their duly appointed associate, my attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to file continuation and divisional applications thereof, to receive the Patent, and to transact all business in the Patent and Trademark Office and in the Courts in connection therewith, and specify that all communications about the application are to be directed to the following correspondence address:

**William F. Lawrence, Esq.
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 745 Fifth Avenue
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Direct all telephone calls
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 William F. Lawrence

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

INVENTOR(S) / Residence

1) Dr. Jan Vermehren, Im Hinterlenzen 33, 65510 Idstein, Germany

Signature: _____ Date: _____

2) Dr. Ernst Schmidt, Römerstrasse 7, 84556 Kastl, Germany

Signature: _____ Date: _____

3) Dr. Mark James Ford, Geierfeld 19, 65812 Bad Soden, Germany

Signature: _____ Date: _____

4) Dr. Richard W.G. Foster, Aventis CropScience UK Limited, Process Development, Hauxton, Cambridge CB2 5HU, Great Britain

Signature: Richard Foster Date: 14 Mar '02

5) Dr. Ian A. Bourne, Aventis CropScience UK Limited, Process Development, Hauxton, Cambridge CB 2 5HU, Great Britain

Signature: Ian Bourne 15 April 2002 Date: 15 April 2002

The inventors are citizens of

1)+2) Germany
3)-5) Great Britain

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22 JAN 2003

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2003 JAN 25 A 11:12

FROMMER, LAWRENCE
& HAUG, LLP

William F. Lawrence, Esq.
Frommer Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151

DOCKETED

In re Application of VERMEHREN et al

U.S. Application No.: 10/089,288

Int. Application No.: PCT/EP00/09466

Int. Filing Date: 28 September 2000

Priority Date: 28 September 1999

Attorney Docket No.: 514413-3917

For: METHOD FOR PRODUCING SUBSTITUTED
PHENYLSULFONYL CARBAMIDES FROM
SULFOHALOGENIDES

DECISION

This is in response to applicant's "Request for Refund" filed 18 December 2002.

BACKGROUND

On 28 September 2000, applicant filed international application PCT/EP00/09466, which claimed priority of an earlier Germany application filed 28 September 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 05 April 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 April 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 March 2002.

On 26 March 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 18 June 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 18 December 2002, applicant filed the present request for refund along with an executed declaration and the fee for a four-month extension of time.

DISCUSSION

Pursuant to 37 CFR 1.26(a), the USPTO may refund any fee paid in excess of that required. In the present case, applicant states that the extension of time fee paid 18 December 2002 should be refunded because the Notification of Missing Requirements was never received. However, applicant has not sufficiently established nonreceipt of the Notification of Missing Requirements.

The showing required to establish nonreceipt of an Office action must include: (1) a statement by the practitioner that the Office communication was not received by the practitioner, (2) a statement by the practitioner that he searched the application file jacket and docket records and that the search indicates that the Office communication was not received, and (3) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

With regard to item (1) above, applicant's representative has provided the required statement.

With regard to item (2) above, applicant's representative has provided the required statement.

With regard to item (3) above, the submitted docket listing for the present application is insufficient. Applicant's representative should supply a docket record which lists responses due to the USPTO on (18) August 2002 and (19) August 2002 for all cases handled by the representative's firm, or if such a docket record is unavailable, for all cases handled by applicant's representative. This docket record must illustrate the absence of any listing of a response due to a Notification of Missing Requirements.

Applicant is advised that the declaration filed 18 December 2002 is improper. Specifically, the declaration contains one cover page and two signature pages. It is not sufficient to submit only the signature page of a declaration, since doing so leaves doubt as to whether each respective signature page was associated with the cover page at the time of execution. Applicant must provide either: 1) a single complete declaration which is presented to and executed by all of the inventors or 2) multiple complete declarations, each of which is executed by at least one inventor.

CONCLUSION

For the reasons above, the request for refund is DISMISSED without prejudice.

If reconsideration on the merits of the request is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are

available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Request for Refund".

The application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), stating that the declaration filed 18 December 2002 is improperly executed.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

A handwritten signature in black ink, appearing to read "Bryan Tung", is positioned above the printed name.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614

Facsimile: 703-308-6459